



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/192,766 11/16/98 BREEDIS

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GREGORY S ROSENBLATT
WIGGIN AND DANA
ONE CENTURY TOWER
NEW HAVEN CT 06508-1832

IM22/0202

EXAMINER

IP.S

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

02/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/16/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) 15-18 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14 are, drawn to copper base alloy product, classified in class 148, subclass 433+.
 - II. Claims 15-18 are, drawn to a process for the manufacture of a copper alloy product, classified in class 148, subclass 554+.
2. The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such as aluminum base alloy product.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. Gregory S. Rosenblatt on January 21, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Specification

6. The Abstract of the Disclosure is objected to because the abstract is too short and does not represent the invention in details with alloying elements' proportions and process steps . Correction is required. See 37 CFR § 1.72 and M.P.E.P. § 608.01(b). A substitute abstract should be filed in response to this action. A comprehensive abstract describing the invention has become very significant, as the abstract is often searched and retrieved through commercial data-searching by the scientific and research community in industry, academic institutions and the patent office.

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," *etc.*

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 13 and 14 are indefinite because the expression "a resistance to stress relaxation at 125°C" is merely a relative expression.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

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on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 6, and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 5-311292 (PTO-1449, page 5 sample no. 13).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- A. Determining the scope and contents of the prior art.
- B. Ascertaining the differences between the prior art and the claims at issue.
- C. Resolving the level of ordinary skill in the pertinent art.
- D. Considering objective evidence present in the application indicating obviousness or unobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 3 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 5311292 (PTO-1449, abstract).

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16. Claims 1-3 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4362579 to Tsuji (PTO-1449, claim 2), JP 4354843 (PTO-1449, abstract), JP 6184679 (PTO-1449, page 2 - [0004]), JP 59126742 (PTO-1449, abstract), or JP 7126779 (PTO-1449, page 2, col. 1).

17. Claims 1-4 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4971758 to Suzuki et al. (PTO-1449, abstract), JP 05311294 (abstract), JP 05311295 (abstract), or JP 06228684 (abstract).

18. Claims 1-5, 7-9 and, 14 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5508001 to Suzuki et al (abstract), JP 04231430 (abstract), JP 05059467 (abstract), JP 07331363 (abstract), JP 06299275 (abstract), or JP 09209061 (abstract).

19. Claims 1-14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06179932 (abstract).

20. The cited references disclose the features substantially as claimed. The disclosed features include the claimed Cu base alloy compositions. The difference between the reference(s) and the claims are as follows: Some references do not disclose the claimed Ni to P ratio. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those

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ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688.

21. Some references may contain additional optional alloying elements, but the instant transitional expression "consisting essentially of" includes the optional alloying elements from the cited references. When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of" applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only a specific portion(s) of the text(s) has been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached Monday to Friday from 6:30 A.M. to 3:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Prince Willis, Jr., can be reached on (703)-308-3050.

The facsimile phone number for "After Final Official Papers" is (703) 305-3599, "All Other Official Papers" is (703) 305-7718, and "Unofficial Papers" is (703) 305-7719. When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'SIKYIN IP', is written over a horizontal line.

**SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742**

S. Ip
January 29, 2000